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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,401	07/27/2000	Thomas A. Cocotis	36.P266	2889

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,401

Applicant(s)

COCOTIS ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the RCE received on 4/12/2004, which paper has been placed of record.
2. Claims 1-52 are pending in this application; claims 47-52 were added.

Response to the amendment

3. Since independent claims 1, 15, 24, 38 are amended to clarify that a determination for selection is made by other than a middle man (i.e., an interactive shop/server) and a service provider. The examiner provides evident herein to show this added claimed idea is old and well-known because that decision can be made by a user. Rejections on 35 U.S.C. 103(a) are moot.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-9,11-14, 16-27 and 29-37, 39-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman (US 5,826,244) in view of Shiota et al. (US 6,324,521), Chui et al. (US Pat. 6,657,702), and further in view of Tannenbaum (DERWENT-ACC-NO: 2000-072115).**

Huberman substantially discloses all the limitations of the listed claims. For example, Huberman teaches a method and system for providing an open document services market over a network comprising a broker acting as an intermediary to match print suppliers with customers through a competitive bidding process. The broker collects information about document services provided by suppliers such as print shops

or publishers, receives orders for print jobs including quantity, quality, time limits and any other requirements needed to complete the job, forwards the job requirements to multiple suppliers, conducts one or more bidding rounds among interested suppliers, awards the job to the supplier or suppliers that fulfill the criteria for a winning bid, and offers the customer the opportunity to select a supplier, select from a group of suppliers, or reject all suppliers and cancel the order. The customer can then communicate order specifics to the supplier via the broker or directly and arrange payment to the supplier upon delivery of the product. The broker collects a fee from the customer, the supplier, or both. Huberman also discloses a subcontracting process whereby a print supplier can win a bid and then act as a customer by subcontracting part of the order to another supplier in a subsequent auction. Prices for recent jobs can be published by the broker to inform suppliers of current market conditions, and standard job information such as price per page for a specific quantity and type of print job can be broadcast in order to attract suppliers who typically produce the type of print service described. (see at least co. 3, line 41 - col. 4 line 23, col. 4 line 45 - col. 5 line 32, col. 8 lines 51-65, col. 13 line 54 - col. 14 line 46).

Chui et al. teach about using a market portal to collect input data or to distribute goods/services (see Chui, 15:20-30).

Both Huberman and Shiota et al. are silent of a user can make a selection directly to choose a service provider.

However, Tannenbaum suggests a user can select a service provider without relying on a broker, that selection is by a party different from a service provider and an interactive shop (see Tannenbaum, the advantage "The user is allowed to select lowest

cost long distance telecommunication service from number of service provider"; see also Tannenbaum, the novelty); or MURATA KIKAI KK. suggests a user can select a telephone number among stored Internet connection providers' telephone numbers, based on cost of service and degree of traffic congestion stored in fee table (see MURATA KIKAI KK , DERWENT-ACC-NO: 1999-086425, 12/04/1998 – G06F 13/00, the abstract).

It would have been obvious to one with ordinary skill in the art to implement Huberman and Shiota et al.'s idea with Tannenbaum (or MURATA KIKAI KK), and Chui et al.'s suggestions because this would give a user plenty of flexibilities in selection between different service providers instead of a selection from a broker/middle-man; therefore, artisan would be appreciate that way of improving business by giving more choices to customers (please note that adding an intermediary for a service provider and an interactive shop does not contribute to the "original steps" of gathering, selecting information for a print service).

5. As per claims 3 and 26, Huberman substantially discloses the claimed invention but fails to teach transmitting digital data from an interactive shop to a service provider. Shiota teaches transmitting digital image data, either scanned from a photograph or taken from a digital camera's memory card, over a network to a minilab or other service provider from a photo shop (see col. 1 line 62 - col. 2 line 42). It would have been obvious to transmit digital image data over a network from an interactive shop such as an over-the-counter minilab, in order to increase customer satisfaction by allowing a customer to select a remote lab or service provider best equipped to fill an order.

6. As per claims 6 and 29, Huberman substantially discloses the claimed invention but fails to teach transmitting an order status to a market portal. Shiota teaches a service provider informing a customer via electronic mail that a print order is ready to be delivered or picked up. It would have been obvious to combine Huberman's document service system with the teaching of Shiota regarding providing an order status, in order to expedite customer retrieval of goods and therefore speedy payment for the completed order.

7. As per claim 21, Huberman substantially discloses the claimed invention but fails to teach establishing an agreement between a service provider and more than one interactive shop. Shiota teaches a network system where interactive shops such as over-the-counter laboratories (also called one-hour-photo labs) interact with a central server or broker and with wholesale labs for providing special services (see col. 7, lines 2-57). It would have been obvious to combine Huberman's document service system with the teaching of Shiota regarding between interactive shops such as minilabs, and a wholesale lab, in order to increase profits for both by allowing them to provide different printing services for customers.

8. Claims 15, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman (US 5,826,244) in view of Shiota et al. (US 6,324,521), Chui et al. (US Pat. 6,657,702), in view of Tannenbaum (DERWENT-ACC-NO: 2000-072115), and further in view of McGovern et al. (US Pat. 5,918,207).

The examiner submits that besides above limitations that are rejectable by above rationales, claims 15, 38 have an extra limitation of determining compatibility between a service provider and an Internet server (acting as a middle-man). Huberman, Shiota et al., Tannenbaum are silent about this feature; however, McGovern et al. suggest that feature in their invention has been made by a patron (see the summary of the invention).

Chui et al. teach about using a market portal to collect input data or to distribute goods/services (see Chui, 15:20-30).

It would have been obvious to one with ordinary skill in the art to implement Huberman and Shiota et al., Chui et al., and Tannenbaum (or MURATA KIKAI KK) suggestion with McGovern's idea because this would give a user plenty of flexibilities in determination before selection of a service provider instead of a selection from a broker/middle-man; therefore, artisan would be appreciate that way of improving business by giving more choices to customers.

9. Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman in view of Shiota, in view of Enomoto et al. (US. 5,974,401), Chui et al. (US Pat. 6,657,702), and further in view of Tannenbaum (DERWENT-ACC-NO: 2000-072115).

Huberman and Shiota substantially disclose the claimed invention but fail to teach selecting service providers in anticipation of an order being placed, or information

reflecting the level of satisfaction associated with a service provider. Enomoto teaches a digital print order system that provides a photofinisher list over the Internet for a customer to select from. The list is updated periodically and includes type of printer equipment at each photofinisher as well as a price table and a delivery date table for each. It would have been obvious to combine Huberman's document service system and Shiota's digital print system with the teaching of Enomoto regarding providing a photofinisher list over a network. Doing so would increase customer satisfaction by allowing a customer to decide which service provider has the equipment and services best suited to their needs and select that provider before placing an order over the network.

Enomoto is silent regarding associating a level of satisfaction with a service provider. However, it is well known in the business world to indicate customer satisfaction when ranking a list of merchants or suppliers, as in consumer guides, and it would have been obvious to provide this feature along with the other listed characteristics of a photofinisher list, in order to further assist customers in choosing a service provider.

Conclusion

10. Claims 1-52 are not patentable.

11. Remarks on combining references:

In re **Bozek**, 163 USPQ 545 (CCPA 1969):

The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce

the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Mapelsden, 51 CCPA 1123, 329 F.2d 321, 141 USPQ 30 (1964). In re Henley, 44 CCPA 701, 239 F.2d 3, 112 USPQ 56 (1956).

In re **Richman**, 165 USPQ 509 (CCPA 1970):

The question in a rejection for obviousness on a combination of references is what the secondary reference would teach one skilled in the art and not whether its structure could be bodily substituted in the basic reference structure.

In re **Van Beckum**, 165 USPQ 47 (CCPA 1971):

We would note that it is well settled that the test of obviousness is not whether the features of one reference can be bodily incorporated into the structure of another and proper inquiry should not be limited to the specific structure shown by the references, but should not be limited to the specific structure shown by the references, but should be into the concepts fairly contained those concepts would suggest to one skilled in the art the modifications called for by the claims.

In re **Henley**, 112 USPQ 56 (CCPA 1956):

The issue lies in what the combination of references makes obvious to the person of ordinary skill and not whether a feature of one reference can be bodily incorporated in the other too produce the subject matter claimed.

12. These cited prior art are also pertinent to claims' subject matters:

- MURATAQ KIKAI KK, (DERWENT-ACC-NO: 1999-086425, 12/04/1998 – G06F 13/00), discloses about communication terminal equipment with E-mail function – selects one telephone number among stored internet connection providers, based on cost of service and degree of traffic congestion stored in fee table (see the abstract).
 - K. H. Chen et al., (UK Patent App. GB 2312594 A, 10/29/1997 – H04Q 3/00), discloses about a direct signaling telecommunication system having separate call servers, invoking and coordinating call services provided to subscriber (see the advantage portion).
 - Agre et al., (US Pat. 6,208,857 B1 – 3/2001 – 455/428), discloses a method and an apparatus for performing position-and-preference-based service selection in a mobile telephone system (see Fig.5 for a subscriber selection among a preferred service provider list).
 - R. J. Dean et al., (DERWENT-ACC-NO: 2000-349479, 4/25/2000 – G06F 17/60); Personalized electronic data services providing apparatus selects electronic data service based on user specific data by comparing user specific data with data describing electronic data services (see Dean et al., the novelty).
 - K. Yahiro, (DERWENT-ACC-NO: 1999-397565, 8/11/1999 – H04M 11/00), Internet telephone apparatus for calling remote location at lower rate by using Internet network (see this article's detail description).
 - Harrington, (US Pat. 5,895,454 – 4/1999 – 705/26), discloses an integrated interface for vendor/product oriented Internet websites (see the abstract).
13. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553.

The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-5572.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

Cuong H. Nguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625